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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER GILLIGAN, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,341

Applicant(s)

MORAG ET AL.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87,89-91 and 94-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87,89-91 and 94-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 1/26/04, the following has occurred: claims 88, 92-93, and 110-118 have been canceled and claims 82, 89, 90, 97, and 108 have been amended. Now, claims 87, 89-91, and 94-109 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 87, 89-91, and 94-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 87 recites the phrase "if a prescription is indicated,..." followed by a series of steps. It is unclear by whom and in what the prescription is "indicated." It is also unclear whether all of the steps following that phrase or only some of the steps following that phrase are to be performed only "if a prescription is indicated."
5. In addition, claims 89-91 and 94-109 are rejected for the same reasons as claim 87 through dependency.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 87, 97-99, and 103-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., U.S. Patent No. 5,911,687 in view of Lion, U.S. Patent No. 6,330,491.

8. Ass per claim 87, Sato teaches a method of messaging over a network between patients and healthcare providers, comprising the steps of: initiating a query message by a patient from a patient-operated computer using a first medical messaging wizard (see column 9, lines 34-37); generating a problem-specific, patient-specific electronic form for said patient to complete by said first medical messaging wizard from a problem-related database and a medical profile for said patient, wherein a form completed by said patient comprises a query message (see column 9, lines 38-39); sending said query message to a workflow engine at a separate network location from said patient-operated computer and attaching said patient's medical profile to said query message by said workflow engine (see column 10, lines 15-23); routing said query message with said attached medical profile to a physician-operated computer at a network location separate from said patient-operated computer and said workflow engine (see column 10, lines 29-32); using a second medical messaging wizard from said physician-operated computer, viewing said query message by a first physician, generating a patient response message and directing said response message to said patient by means of said workflow engine (see column 10, lines 40-42); if a prescription is indicated, embedding a prescription in said response message by said physician by means of said workflow engine (see column 10, lines 43-47); routing said embedded prescription to a pharmacy of choice selected by said patient by means of said workflow engine, wherein said workflow engine automatically updates said medical profile with said prescription (see column 10, lines 43-47); appending a billing to said response by means of said second medical messaging wizard and sending billing data to said workflow engine, wherein said workflow engine directs said patient response having said

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appended billing to said patient (see column 7, lines 10-15); routing messages among physicians and physician extenders by means of said workflow engine (see column 10, lines 52-57); wherein said workflow engine integrates a plurality of operations as a single medical profiler process, said medical profiler process including at least updating of said medical profile, attaching said medical profile to patient queries directed to said physician-operated computer, billing operations and prescribing operations (see column 5, lines 2-17); and wherein said patient-operated computer and said physician-operated computer are intermittently connected to said network, and wherein exchange of messages is asynchronous (see column 5, lines 27-32).

9. Sato does not explicitly teach sending said patient response message having said embedded prescription to said patient, viewing said prescription by said patient, and routing said prescription by said patient to a pharmacy. However, Lion, teaches routing an electronic prescription from a patient to a pharmacy for filling (See column 5, lines 18-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Sato. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of enhancing the ability of patient needs to receive prescription medication in a variety of circumstances (See column 1, lines 30-47 of Lion).

10. As per claim 97, Sato in view of Lion teach the method of claim 87 as described above. Sato further teaches generating a billing report from said medical profile of said patient (see column 7, lines 10-15).

11. As per claim 98, Sato in view of Lion teach the method of claim 97 as described above. Sato further teaches said network including a billing system accessing said network at a billing system address on said network, and further comprising steps of: sending said billing report

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from said medical profile of said patient to said billing system address (see column 2, lines 58-63); and billing said patient from said billing report (see column 7, lines 10-15).

12. As per claim 99, Sato in view of Lion teach the method of claim 98 as described above. Sato further teaches billing said patient comprises generating at least one insurance bill for said patient to a corresponding insurance provider (see column 7, lines 10-15).

13. As per claims 103-105, Sato in view of Lion teach the method of claim 87 as described above. Sato does not explicitly teach the messaging protocols recited. However, Lion teaches messaging protocols that support email, TCP/IP, and the World Wide Web (see column 5, lines 16-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such messaging protocols into the system of Sato. One of ordinary skill in the art would have been motivated to incorporate such protocols for the purpose of expanding the location-independent treatment options for patients using the system of Sato (see column 1, line 66 – column 2, line 6 of Sato).

14. As per claims 106 and 107, Sato in view of Lion teach the method of claim 87 as described above. Sato further teaches the message wizards are implemented as a computer program residing on a computer readable medium accessible by physician and patient operated computers (see column 2, lines 38-47).

15. AS per claim 108, Sato in view of Lion teach the method of claim 87 as described above. Sato further teaches said workflow engine resides on at least one server capable of accessing said network to receive and send messages (see column 2, lines 7-13).

16. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., U.S. Patent No. 5,911,687 in view of Lion, U.S. Patent No. 6,330,491 and further in view of Colvin, U.S. Patent No. 5,825,881.

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17. As per claim 89, Sato in view of Lion teach the method of claim 87 as described above. The combination of Sato and Lion do not explicitly teach the encryption and decryption process as claimed. However, Colvin teaches encrypting a query message at a client computer and decrypting said encrypted query message at said workflow engine (Colvin; col. 14, lines 4-17; the examiner interprets the "central server" as the "workflow engine"); encrypting said decrypted query message at said workflow engine (Colvin; col. 14, lines 13-15); decrypting said query message from said workflow engine at a client computer (Note Colvin teaches the client decrypting a message with its respective encryption key Colvin; col. 6, lines 15-40) ; and any of the steps of: decrypting said encrypted response message at said workflow engine; and decrypting said encrypted response message at a client computer (Colvin; col. 14, lines 1-17; It is respectfully submitted, that the central server can decrypt messages from the second client computer system similar to the way it does with messages from the first client computer system). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such an encryption and decryption process into the system of Sato. One of ordinary skill in the art would have been motivated to incorporate such a process for the purpose of reducing the risk that confidential information will be intercepted or misused (Colvin; col. 2, lines 20-22).

18. Claims 90-91, 96, and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., U.S. Patent No. 5,911,687 in view of Lion, U.S. Patent No. 6,330,491 and further in view of Falchuk et al., U.S. Patent No. 6,256,613.

19. As per claim 90, Sato in view of Lion teach the method of claim 87 as described above. Sato does not explicitly teach the additional routing of a message. However, Falchuk teaches routing a query message with an attached medical profile to a physician extender using a

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computer at a separate network location (Falchuk; abstract; the examiner interprets the “staff physician” as a form of “physician extender”); selecting a first of said physician extenders (Falchuk; abstract; the examiner interprets the “client computer” as the “medical profiler”); using a medical message wizard (Falchuk; abstract; the examiner interprets the means to “display request for preliminary review” as the “medical message wizard”); viewing said query message by said physician extender (Falchuk; abstract); generating a proposed response message to said query message (Falchuk; abstract; the examiner interprets the “request” sent to the “specialist” as the “proposed patient response message”); attaching said proposed response message to said query message (Falchuk; abstract); routing said query message with said proposed response message to said first physician (Falchuk; abstract; the examiner interprets the “specialist” as the “first-physician”); and generating said response message by said first physician using said medical message wizard based on said proposed response message (Falchuk; abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such additional communication with physician extenders. One of ordinary skill in the art would have been motivated to incorporate such communication for the purpose of providing managed, direct access to outside medical consultants, therefore help avoid inaccurate, incomplete, or uncertain diagnoses which can result in inappropriate or excessive care (Falchuk; col. 1, lines 40-43).

20. As per claim 91, Sato in view of Lion and Falchuk teach the method of claim 90 as described above. Sato further teaches said physician extender comprises either an administrator or a physician assistant (see column 3, lines 42-54).

21. As per claim 96, Sato in view of Lion and Falchuk teach the method of claim 90 as described above. Sato further teaches implementing the messaging wizards as a computer

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program residing in computer readable media accessible by said physician extender operating said computer (see column).

22. As per claim 100, Sato in view of Lion teach the method of claim 87 as described above. Sato does not explicitly teach claimed second opinion feature. Falchuk teaches generating a first-physician-second opinion request message (Falchuk; abstract; the examiner interprets the "staff physician" as the "first physician" and interprets the "request for consultation, together with at least an identification of the selected supporting documentation" as the "first-physician-second-opinion request message"); sending said first-physician-second opinion request message to a second physician at a corresponding physician address (Falchuk; abstract); viewing said second opinion request message by said second physician (Falchuk col. 4, lines 48-52); generating a second opinion message by said second physician; and sending said second opinion message to said first physician (Falchuk; abstract). It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Sato and Lion with Falchuk's teachings with regards to these limitations. One of ordinary skill in the art would have been motivated to incorporate such features for the purpose of providing managed, direct access to outside medical consultants, therefore help avoid inaccurate, incomplete, or uncertain diagnoses which can result in inappropriate or excessive care (Falchuk; col. 1, lines 40-43).

23. Claims 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., U.S. Patent No. 5,911,687 in view of Lion, U.S. Patent No. 6,330,491 and Falchuk et al., 6,256,613 and further in view of Business Wire ("Merck-Medco and Physicians' Online Pilot New suite of Internet Applications To Facilitate Physician and Pharmacist Communications At the Point of Prescribing," Business Wire, October 22, 1998).

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24. As per claim 94, the combined system of Sato, Lion, and Falchuk fail to expressly teach embedding a proposed prescription refill in said proposed response. However, this feature is old and well known in the art, as evidenced by Business Wire's teachings with regards to embedding a proposed prescription refill in said proposed response (Business Wire; page 2, paragraph 2). It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Sato, Sloane, Lion, and Falchuk with Merck-Medco's teachings with regards the above limitations. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of facilitating communications at the point of prescribing between pharmacists and physicians (Business Wire; page 1; paragraph 1).

25. The combined system of Sato, Lion, Falchuk, and Business Wire fail to expressly teach said physician extender comprises a nurse. However, it is respectfully submitted, that such a limitation is directed to who or what utilizes the claimed invention rather than a limitation drawn to what the claimed invention is, as such it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Sato, Lion, Falchuk, and Business Wire to have said physician extenders as a nurse, with the motivation of freeing up physicians, by enabling their support personal to perform the functions required by the system.

26. As per claim 95, the combined system of Sato, Lion, and Falchuk fail to expressly teach the limitations of this claim. However, this feature is old and well known in the art, as evidenced by Business Wire's teachings with regards to reviewing said proposed prescription refill by said first physician and any of the steps of: approving said proposed prescription refill; revising said proposed prescription refill; deleting said proposed prescription refill; and embedding a second prescription (Business Wire; page 1, paragraph 4). It is respectfully submitted, that it would

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have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Sato, Lion, and Falchuk with Business Wire's teachings with regards the above limitations, with the motivation of facilitating communications at the point of prescribing between pharmacists and physicians (Business Wire; page 1; paragraph 1).

27. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., U.S. Patent No. 5,911,687 in view of Lion, U.S. Patent No. 6,330,491 and further in view of Donohue et al., U.S. Patent No. 5,987,480.

28. As per claim 101, Sato in view of Lion teach the method of claim 87 as described above. Soato does not explicitly teach maintaining a collection of patient response templates, wherein said first physician invokes one of said collection of templates in responding to said query message. However, Donohue teaches maintaining a collection of patient response templates, wherein said first physician invokes one of said collection of templates in responding to said query message (Donohue; abstract; it is respectfully submitted that "said first physician" is a form of "client"). It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the system of Sato to incorporate these features. One of ordinary skill in the art would have been motivated to incorporate such features for the purpose of providing web pages to users which are customized and individualized to each users particular needs and interest (Donohue; col. 3, lines 9-11).

29. Claim 102 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., U.S. Patent No. 5,911,687 in view of Lion, U.S. Patent No. 6,330,491 and further in view of Pinsky et al., U.S. Patent No. 5,469,353.

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30. As per claim 102, Sato in view of Lion teach the method of claim 87 as described above. Sato does not explicitly teach the remaining steps of the claim. However, Pinsky teaches maintaining a routing table including at least one routing directive to said first physician (Pinsky; col. 4, lines 5-26; the examiner interprets "resource of available Network interpretation sites" as a "routing table including at least one routing directive to said first physician"); wherein sending said patient medical query message to a first physician with said corresponding physician address further comprises: examining said routing table based upon said patient medical query message to find a first of said routing directives to said first physician compatible with said patient medical query message (Pinsky; col. 4, lines 16-26; the examiner interprets the "Study" as a form of "medical query message"); and finding said first routing directive to said first physician compatible with said patient medical query message (Pinsky; col. 4, lines 16-26). It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the system of Sato to incorporate these features. One of ordinary skill in the art would have been motivated to incorporate such features for the purpose of matching the patient request with the physician best equipped and able to handle the specific needs of the request (Pinsky; col. 3, lines 41-53).

Response to Arguments

31. In the remarks filed 1/26/04, Applicant argues in substance that the applied prior art does not teach certain features of the amended claims. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection detailed above.

Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/15/06


C. LUKE GILLIGAN
PATENT EXAMINER